

REMARKS

Claims 1 to 6, 8 to 24, and 26 to 30 are now pending in the application. Claims 7 and 25 stand cancelled, and Claims 28 to 30 stand withdrawn. The Examiner is respectfully requested to reconsider the claims and withdraw the rejections in view of the remarks contained herein.

REJECTION UNDER 35 U.S.C. § 103 OVER FORD ET AL IN VIEW OF SCHNEGG AND WOODALL, JR.

Claims 1 to 2, 4, 5, 8, and 10 to 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ford et al (U.S. Pat. No. 5,556,495) in view of Schnegg (U.S. Pat. No. 5,191,777) and Woodall, Jr. (U.S. Pat. No. 3,882,857). These rejections are respectfully traversed.

A claim is not rendered obvious by the mere fact that references can be combined or modified. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Additionally, if a proposed modification results in the prior art device being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Applicant respectfully submits that the prior art does not suggest the desirability of substituting the weft inserted warp knit of Schnegg for the spirally woven fabric of Ford. For example, the Ford reference teaches at col. 2, lines 11 to 16:

[A]pplicants have recognized a need for shaped fabric products and particularly for tubular fabrics, which are at once shape-retaining, kink-resistant and flexible. Furthermore, applicants have recognized the failure of the prior art to provide methods for manufacturing woven tubular products which possess these characteristics . . .

Accordingly, it is an object of the present invention to provide improved methods of manufacture of flexible, kink-resistant fabric covers.

(Emphasis added). Further, at col. 2, lines 37 to 58, the Ford reference states:

The present invention provides flexible, kink-resistant shaped fabric products According to important aspects of the present invention, the shaped fabric products include a wall portion comprising a filament resiliently set in a spiral configuration with respect to the longitudinal axis of the shaped product. Applicants have found that tubular products comprising fabrics and preferably woven fabrics having such spirally set filaments generally possess excellent flexibility and exceptional kink- and abrasion-resistance.

(Emphasis added). Therefore, Ford clearly demonstrates that the spiral configuration of the woven fabric is a critical element that renders the Ford invention satisfactory for its intended purpose, i.e. a kink-resistant fabric product.

Substitution of the spirally set filament of Ford with the weft inserted warp knit of Schnegg would render the fabric product of Ford unsatisfactory as a kink-resistant fabric product. The spiral configuration imparts the shape-retention and kink-resistance to the product. The knit of Schnegg does not have a spiral configuration, and therefore is not kink-resistant. Regardless of whether the knit of Schnegg may be made at higher speed and lower costs, one of the ordinary skill in the art would not be motivated to modify the Ford reference due to the difference in properties. Therefore, the prior art does not suggest the desirability of the combination, and a *prima facie* case for obviousness fails with regard to the present claims.

Even if a suggestion or motivation were found, a *prima facie* case of obviousness is rebutted because the art teaches away from the claimed invention in a material respect. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

In particular, Ford teaches away from fabrics other than those having filaments resiliently set in a spiral configuration. "According to important aspects of the invention, the shaped fabric products include a wall portion comprising a filament resiliently *set in a spiral configuration* with respect to the longitudinal axis of the shaped product." Col. 2, lines 42-46, emphasis added. This fabric configuration is a material aspect of the invention claimed by Ford. The Ford reference teaches away from the weft inserted warp knit of Schnegg, which does not have filaments in a spiral configuration, nor the kink-resistant properties associated with such a fabric. Accordingly, any *prima facie* case of obviousness is rebutted.

Applicant further submits that the Woodall reference is not reasonably pertinent to the particular problem with which claims are concerned. A reference is not reasonably pertinent if the matter with which it deals does not logically commend itself to an inventor's attention when considering his problem. *See, Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). As read in light of the specification, the claimed subject matter is concerned with resilient tubular sleeves for bundling wire, cable, tubing, etc. Specification at paragraph [0002]. The sleeves exhibit variable characteristics including, for example, abrasion resistance, flame-retardant capability, high temperature capability, and/or EMI/RFI shielding. Specification at paragraph [0023].

In contrast, the Woodall reference describes an orthopedic cast in which yarn is textured or bulked to provide greater body or softness, presumably for the comfort of a wearer. *See Woodall Jr.* at col. 4, lines 1-15. Softness of hand, air permeability, antibacterial properties, rigidity, and immobilization are matters with which Woodall Jr.

deals. See Woodall Jr. at col. 3, lines 37-63; and col. 4, lines 1-37. Furthermore, the orthopedic cast of Woodall Jr. is a hard and rigid structure for immobilization of a body part. Immobilization does not mean “protection” in the sense described by the Examiner in the Final Office Action. Such a rigid and immobilizing structure would be unsuitable as a resilient tubular sleeve for bundling cables, wires and/or tubing, wherein the required “protection” includes abrasion resistance, flame-retardant capability, high temperature capability, etc.

One of ordinary skill in the art would not look to orthopedic cast teachings to modify resilient sleeves for bundling wires, cables, etc. The claimed subject matter requires very different physical properties. Therefore, Woodall Jr. does not logically commend itself to the problems addressed by the claims, and is not analogous art. For at least this further reason, there is no suggestion or motivation to modify the Ford, Schnegg, and Woodall Jr. references.

Moreover, the combined references cited by the Examiner do not describe every element of the claims. A prior art reference or references when combined must also disclose all claim limitations. Specifically, the Schnegg reference does not describe a set of knitted warps including a plurality of textured second multifilament yarns forming a chain stitch lap in said fabric cloth. In particular, the Schnegg reference does not describe multifilament yarns forming a chain stitch lap. Single and multifilament yarns are only described with respect to the weft and warp yarns 1a to 5a, and not the stitch wales 14a of the reference. Col. 6, lines 59-66; and col. 7, lines 4-13. Nor does the Ford and Woodall Jr. references provide the disclosure absent from the Schnegg

reference. Accordingly, the prior art references do not disclose all the limitations of the instant claims.

In light of above arguments, Applicant respectfully asks the Examiner to reconsider the rejection made in the Final Office Action. Applicant respectfully submits that the claims are patentable over the combined references of Ford, Schnegg, and Woodall Jr., and respectfully requests that the rejection be withdrawn.

FURTHER REJECTIONS UNDER 35 U.S.C. § 103

Claims 3, 6, 9, 13 to 24, 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ford, Schnegg and Woodall Jr. in view of various additional references, or combinations of references, including Boyd et al. (U.S. Pub. No. 2005/0017402), Keogh et al. (U.S. Pub. No. 2002/0098357), Stanhope et al. (U.S. Pat. No. 5,556,495), Bettcher et al. (U.S. Pat. No. 5,070,540). These rejections are respectfully traversed.

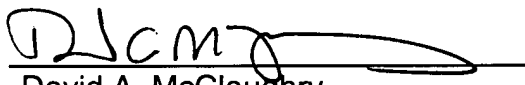
Applicant believes that a *prima face* case for obviousness fails in light of the above arguments. Also, the additional references do not provide the elements absent from the combined Ford, Schnegg, and Woodall Jr. references. Accordingly, Applicant respectfully requests that all the rejections based on these references be withdrawn.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable reconsideration of the claims is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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